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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,334	01/28/2005	Siegfried Ginter	3401-146PUS	5762
27799 7590 08/06/2008 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER				
ROY, BAISAKHI				
ART UNIT		PAPER NUMBER		
3737				
MAIL DATE		DELIVERY MODE		
08/06/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/523,334

## Applicant(s)

GINTER ET AL.

## Examiner

BAISAKHI ROY

## Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 4/29/08 have been fully considered but they are not persuasive. Johnson et al. teach a method of producing a local temperature increase to the center of a tumor and less to the periphery in order to produce higher temperatures and ensure complete ablation at the center and minimize risk of thermal injury to surrounding healthy tissue [0105]. Therefore the temperature at the ablation is monitored and increased as necessary based on the proximity to the necrosis site. Upon further consideration, a new ground(s) of rejection is also made in view of recent developments to 35 U.S.C. 101.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-33 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This new rejection is in view of the Interim Guidelines published on November 2005, incorporated into MPEP 2106 and views presented by the PTO on subject matter eligibility of process claims to the Court of Appeals for the Federal Circuit in *In re Bilski*, Appeal No. 2007-1130. Based on Supreme Court precedent and recent Federal Circuit decisions, a § 101 process must be tied to another statutory class (such as an apparatus) and must positively recite the subject matter that is being transformed by identifying the material that is being changed

to a different state. Therefore the method claims must positively recite the tied apparatus and must also recite the end result or physical transformation taking place.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (2002/0077627). Johnson et al. disclose a method for producing a local temperature increase within a body of material such as a biological material containing the target region using focused sound signals in a target region, wherein the target region comprises a volume situated proximate to the focus of the focused sound signals [0098, 0105, 0109, 0111, 0120-0123]. Johnson et al. teach said method to include generating a sound signal in the target region by radiating the sound signal from a sound emitter in response to a pressure-time signal such that a magnitude of the pressure amplitude of the sound signal in the target region is larger than the expansion amplitude of the sound signal in the target region, and adapting the pressure-time signal such that the pressure-time course of the sound signals in the target region is adapted to a specific utilization of the non-linear propagation and attenuation properties of the material in the target region such that an increase in the temperature in the target region produced by the adapted pressure-time signal is greater than a temperature increase

produced by a sinusoidal pressure-time signal having the same power [0125-0126]. Johnson et al. teach the use of several superimposed mono-frequency signals [0049] superimposed with asymmetrical sound signals (fig. 31). The apparatus includes a piezoelectric emitter equipped with piezoceramics [0099] with natural resonances which differ from one another for producing at least two different sound signals acting simultaneously in the target region [0006, 0059, 0063, 0068, 0069, 0073, 0075]. Johnson et al. further teach the step of providing an ultrasound image using a picture-providing method [0067, 0068, 0104, 0106, 0108, 0117].

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BAISAKHI ROY whose telephone number is (571)272-7139. The examiner can normally be reached on M-F (7:30 a.m. - 4p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian L Casler/  
Supervisory Patent Examiner, Art  
Unit 3737

BR  
/B. R./  
Examiner, Art Unit 3737